

### **Remarks**

Claims 1-6, 8-9, 12-16, 19-21, and 24-27 are presented for the Examiner's review and consideration. Claims 8-9, 12-13, and 19-22 are withdrawn. In this Response, claims 8 and 19 are amended, claims 17-18 and 22-23 are cancelled, and claims 24-27 are added. Applicant believes the claim amendments and the accompanying remarks herein serve to clarify the present invention and are independent of patentability. No new matter has been added.

#### **Election/Restriction**

Newly submitted claims 22 and 23 were withdrawn, as provided for in 37 CFR 1.142(b) and MPEP §821.03. Applicant notes that claims 22-23 are cancelled herein, rendering the requirement for withdrawal moot. Applicant further notes that claim 8 has been amended to depend from claim 1. Accordingly, Applicant respectfully requests rejoinder of claim 8 and dependent claim 9 upon the allowance of claim 1.

#### **35 U.S.C. §103 Rejections**

Claims 1-6, 14, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,151,586 to Brown ("Brown") in view of U.S. Patent No. 5,722,418 to Bro ("Bro"). Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Bro as applied to claim 15 and further in view of U.S. Patent No. 6,085,976 to Sehr ("Sehr"). For reasons set forth below, Applicant respectfully submits that this rejection should be withdrawn.

As an initial matter, it is noted that the references are described separately only to clarify the teachings of each reference. Thus, the presentation of references separately is not and should not be construed as an attempt to "argue references separately." It is further noted that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). However, a simple teaching of elements is insufficient. In order to establish a proper *prima facie* case of obviousness, the prior art must also suggest the desirability of the claimed invention and/or give

some reason for references to be combined. Therefore, in order to properly establish a *prima facie* case of obviousness, a rejection must not only show that all elements of the claimed invention are known or suggested in the prior art, but must also show that one of ordinary skill in the art would have some reason or motivation to put all the elements together to achieve the claimed invention.

*Brown*

As indicated in the rejection, Brown discloses a program for a specific disease, but does not define general program areas that relate to specific program areas, and fails to teach awarding points separately to general and specific program areas, and associating levels of performance.

*Bro*

As cited in the rejection, Bro teaches general activities, including nutrition and exercise (C11L18-22). The rejection cites Bro C12L47-53, for relating general and specific diseases: “Another object of the invention is that the use of an expert and the patient program may be directed to the field of chronic disease detection. More particularly, the patient program will provide periodic behavioral cues to aid the expert in the early diagnosis and cure of such chronic diseases as glaucoma, dental and periodontal disease, cancer, heart disease, and diabetes.”

Applicant respectfully submits the foregoing pertains to treating chronic diseases, specifically, and makes no mention of how such treatment would relate to treatment for a general disease. The mere mention of exercise or weight loss in the same reference does not relate the activities as recited in the claims of the instant invention. More particularly, claim 1 recites, *inter alia*, “general programme areas...of benefit to a member stricken with any disease” and “specific programme areas...of particular benefit to a member afflicted with some but not all of the diseases”, and “a second level, wherein the member is awarded a bonus set of points...in response to participating in *all* programme areas *associated* with a disease with which the member is afflicted”. Thus, there are two sets of programme areas which together constitute *all* programme areas, and it is only *after participating in all programme areas associated with a disease*.

Thus, as Brown does not, at least, disclose general programs, and as Bro does not *connect* general activities and specific activities in any particular way, and further does not suggest or

teach **only** awarding points after a particular set of all activities associated with a disease have been participated in, no combination of the references could produce the invention of claim 1.

New claim 24 recites, *inter alia*, **associating** at least one general set of activities to at least one specific set of activities **to form a combined set of activities**. It is **only after** a participant has engaged in all activities of this combined set, that points may be awarded in a second set of points. Brown and Bro are silent not only to this specific combination, but also to the **temporal** aspect of a points award based on completion of participation in all elements of the combined set. Claim 27 contains similar recitations.

The combined set of two program activities types leverages a program of general activities, which may be highly developed, with targeted programs directed to a specific disease. The combination recognizes the pivotal importance of certain general activities in addressing specific diseases, and exploits both the synergy of the general and specific programs, as well as a member's desire to not only obtain better health, but to enjoy the benefits and challenges offered by a points reward program. Further, a particular points award is *delayed* until a comprehensive effort has been demonstrated with respect to an entire combined set.

Accordingly, Applicant respectfully submits that claims 1, 24, and 27 are patentable over a combination of Bro and Brown. As claims 2-6, 8-9, and 14-16 depend from claim 1, and claims 19 and 25-26 depend from claim 24, these dependent claims necessarily include all the elements of their base claim. Accordingly, Applicant respectfully submits that the dependent claims are allowable over the cited references for at least the same reasons.

In light of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the §103 rejection.

### Conclusion

In light of the foregoing remarks, this application is now in condition for allowance and early passage of this case to issue is respectfully requested. If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

No fee is believed to be due for this submission. However, please charge any required fee (or credit overpayments) to the Deposit Account of the undersigned, Account No. 500601 (Docket No. 7802-A08-002)

Respectfully submitted,

/ Paul D. Bianco /

Paul D. Bianco, Reg. 43,500

Customer Number: 33771  
FLEIT GIBBONS GUTMAN BONGINI & BIANCO  
21355 East Dixie Highway, Suite 115  
Miami, Florida 33180  
305-830-2600, fax 305-830-2605, pbianco@fggbb.com